

### REMARKS/ARGUMENT

Claims 1 through 17 are pending. All of the claims are independent except for claim 9. Applicant notes with appreciation the allowance of claims 3, 5, 6, 15 and 16.

Applicant maintains his position that the abstract meets all the statutory and regulatory requirements. However, in the interests of expediting prosecution, the abstract has been amended to remove the expression "means," as requested by the Examiner and as recommended, though not required, by the MPEP. Withdrawal of the objection is requested.

In the Office Action, with regard to the form PTO-1449 from the Information Disclosure Statement dated April 21, 2000, the Examiner stated that the references on that form would not be considered because the Japanese documents were not originally provided. However, this is not the case. The April 21, 2000 paper was filed originally by certificate of first class mail, as is evidenced by the copy of the executed certificate on the enclosed copy of the Statement. When that paper was filed, the present case was being handled by the firm of Ostrelenk, Faber, Gerb & Soffen. The stamped return receipt postcard is not available to Applicant's current attorneys at Dickstein Shapiro Morin & Oshinsky. However, our file does contain a photocopy of the unstamped return receipt postcard that was filed with the Statement. As can be seen from that copy, the postcard filed with the Statement indicated that copies of all the references were in fact filed with the April 21, 2000 paper.

As a courtesy to the Examiner, a complete set of the cited references, together with a copy of the originally-filed Information Disclosure Statement, is submitted herewith. Although it is believed that the \$180.00 for consideration of these documents is not due, in view of the fact that the references were in fact previously provided, should the Examiner deem that this fee is due for consideration of the cited references at this time, the U.S. Patent and Trademark Office is authorized to charge the \$180.00 fee to Deposit Account No. 50-2215.

As to the assumption regarding “P/1878-135,” that number is the original Ostrolenk attorney docket number of the present case and *does not* relate to the foreign Office Action.

In the Office Action, Claim 7 was rejected under 35 U.S.C. § 102(e) over U.S. Patent No. 6,018,552 (“Uesugi”). Claims 1, 2, 4, 8 and 10-14 were rejected under 35 U.S.C. § 103 over U.S. Patent No. 6,122,295 (“Kato”) in view of U.S. Patent No. 5,712,869 (“Lee”). Claims 9 and 17 each were rejected under 35 U.S.C. § 103 over Kato in view of Lee and further in view of Rappaport (“Wireless communication”).

In view of the remarks set forth below, the Applicant requests reconsideration of the Examiner’s rejections.

#### I. Rejection of Claim 7

In the Office Action, claim 7 was rejected under Section 102(e) as being anticipated by Uesugi. Uesugi, however, fails to disclose each and every limitation of claim 7.

Claim 7 is directed to a level adjusting circuit that includes: a plurality of bit shifters that shift input baseband signals to the right by different certain bits, a plurality of switches for selecting outputs from said respective bit shifters in accordance with a desired gain desired to be set, and an adder for adding outputs from said respective switches for output as one signal.

In order to support a prima facie case of anticipation, the single reference applied against the claim in question must clearly teach, either explicitly or inherently, each and every recited element, giving each word of each limitation patentable weight. In the present case, the Office Action took the position that Uesugi’s Figure 16 shows every feature of claim 7. However, while Uesugi shows bit shifters, it does not, among other things, teach the recited

plurality of switches for selecting outputs from the respective bit shifters in accordance with a desired gain.

## II. Rejection of Claims 1, 2, 4, 8-14 and 17 Under Section 103

Claim 1 recites, inter alia, D/A converting means for converting the baseband signal which is a digital signal outputted from the level adjusting means into an analog signal; and gain setting means for calculating a gain set value with which the amplitude value of the baseband signal outputted from the level adjusting means is adjusted to an amplitude value matching a dynamic range of the D/A converting means based on the number of transmission codes which is the number of multiplexed baseband signals, and for notifying the level adjusting means of the gain set value with the control signal. In the Office Action, it is conceded that Kato does not disclose these limitations. To remedy this deficiency in Kato, the Office Action cites Lee.

As is discussed in the Background of the Invention section of the present specification, a problem with conventional baseband signal multiplexing circuits is that the signal applied to the D/A converter may vary in amplitude so as to disadvantageously introduce D/A converter quantization error by failing to fully use the dynamic range of the D/A converter. The inventors of the present invention solved this problem by calculation of a gain set value with which the amplitude value of the signal applied to the D/A converter has been adjusted so as to match the dynamic range of the D/A converter.

In Kato, however, as was conceded in the Office Action, there is **no** teaching of a D/A converter for converting the baseband signal, which is a digital signal, into an analog signal. In view of this, there is, of course, no recognition of any problem related to failing to properly utilize the dynamic range of the D/A converter, such as the problem encountered in the conventional system shown in Figure 1 of the present application, and solved by the present invention, in particular by the structure defined by claim 1.

Further, in view of the non-existence in Kato of the above-mentioned D/A-converter-associated problem, there would have no motivation modify Kato to fix the (non-existent) problem of the conventional transmitter by applying a gain set value in any way related to the non-existent D/A converter, still less the gain set value as recited in claim 1. To get around the inconvenient absence of a D/A converter in Kato, the position was taken in the Office Action that it would have been obvious to first **add** a D/A converter to Kato, which has no indication that it needs one, thus allowing Kato to be **further** modified to add gain setting means to calculate a gain set value based upon the dynamic range of the newly added D/A.

However, the **only reason** to make this further modification would be because of the Examiner's proposed addition of the D/A converter, which, as was mentioned above, does not appear to be needed in Kato. Thus, the addition to Kato of the D/A converter, as proposed in the Office Action, amounts to adding a potential problem area to Kato, and then fixing the added problem with additional structure that would not have been needed but for the addition of the problem.

No one would have been motivated to add a problem just to add further structure to solve it, and for at least this reason no one would have been motivated to make the proposed changes to Kato set forth in the rejection. The only conceivable motivation for the illogical combination of features set forth in the rejection is the need to meet the claim features, which of course is not a proper motivation. Adding structure not needed in the primary reference, just so that additional structure can be added to ameliorate possible problems with the added structure, is a textbook example of an improper hindsight reconstruction of claim 1.

No one would introduce structure, in this case the D/A converter, just to introduce additional structure to prevent the problems associated with the added structure. It does not

make sense and cannot form the basis for an obviousness rejection, for at least the reasons outlined above. Moreover, the motivation, if any, for the second proposed modification of Kato is a synthetic one. That is, it would not exist but for the initial modification of Kato to add the D/A converter. Of course, as discussed above, there would have been no motivation to add the D/A converter in first place.

In summary, there is no conceivable motivation to modify Kato to first add a D/A converter, with its associated problems related to dynamic range, as shown in the applicant's prior art, only to then add further structure to set a gain set value so that the dynamic range problem is solved. That is, no motivation would exist except to meet the features of the claim, which is completely improper. In addition, the Office Action concedes that **neither Kato nor Lee** teaches the feature by which the gain set value is calculated in a manner that is in any way related to the dynamic range of the D/A converter.

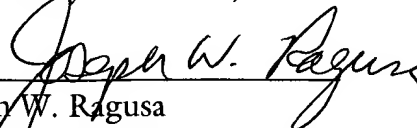
It is not enough that it would have been *possible* to modify a primary reference so as to meet claim features. There must be some teaching in the prior art that would have motivated a person of ordinary skill in the art to actually make the modification. For at least the reasons mentioned above, there would have been no such motivation.

Accordingly, no prima facie case of obviousness has been set forth in the Office Action and withdrawal of the rejection is respectfully requested. For at least the reasons delineated above, the Office Action fails to set forth a prima facie case of obviousness against claim 1. Claims 2, 4, 8, 10-14 and 17 recite similar features and are believed patentable for similar reasons.

In view of the foregoing remarks, Applicant respectfully requests favorable reconsideration and early passage to issue of the present application.

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Respectfully submitted,

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